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JGJR.: 06-05

Paper No: ____

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OFFICE OF PETITIONS

In re Application of	:	
Rapier	:	
Application No. 10/613,306	:	DECISION ON PETITION
Filing Date: 7 July, 2003	:	
Attorney Docket No. (None)	:	

This is a decision on the petition filed on 30 August, 2004, alleging, *inter alia*, unavoidable delay under 37 C.F.R. §1.137(a), and in light of the allegations of non-receipt, considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition:

- under 37 C.F.R. §1.137(a) is **DISMISSED**; and
- as considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181 is **DISMISSED**.

NOTES:

- (1) There should be no need for further petition in this matter, however, to the extent that Petitioner finds need therefor, any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative

request for relief under 37 C.F.R. §1.137(b)¹ (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";

- (2) Thereafter, there will be no further reconsideration of this matter.
- (3) It appears that Petitioner may not have updated his contact information (including telephone) with the Office of Enrollment and Discipline, and Petitioner is encouraged to correct this oversight without delay.

PLEASE TAKE SPECIAL NOTE:

Petitioner appears:

- to have filed two separate applications on the same date but on behalf of two different applicants, and which were assigned application numbers only two digits apart by the Office; and
- not to have designated docket numbers for the respective applications.

The Office mailed no Notice of Abandonment in the instant file, however, the Office did mail a Notice of Abandonment in the other file.

Nonetheless, Petitioner continues to file petitions to revive under 37 C.F.R. §1.137—alternatively pleaded to be considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181—in the instant pending application, rather than the other application, which is abandoned.

Petitioner, as one registered to practice before the Office, is aware that under the provisions of 37 C.F.R. §1.4:

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

* * *

(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent, patent file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence in the file of an application, patent, or other proceeding.

* * *

Moreover:

* * *

(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

* * *

Petitioner must address the question of abandonment of the other application, as the rules require, in the other application.

BACKGROUND

The record reflects that:

- as noted above, Petitioner has twice filed a petition to revive in the instant application (Application No. 10/613,306 (the '306 application')) in an attempt to address an abandonment matter in an application that Petitioner apparently filed contemporaneously for another applicant and bearing a proximate but other application number (Application No. 10/316,308 (the '308 application));
- the Office mailed on 2 October, 2003, a Notice to File Corrected Application Papers (drawings) in the '308 application, with reply due on or before 2 December, 2003, and Petitioner has never replied to that Notice;
- the Office mailed on 6 November, 2003, a Notice to File Corrected Application Papers

(drawings) '306 application, with reply due on or before 6 January, 2004, and Petitioner replied to that Notice on 14 November, 2003;

- the Office mailed a Notice of Abandonment in the '308 application on 19 October, 2004, and thereafter Petitioner filed the original petition on 19 November, 2004—however, Petitioner filed the petition in the '306 application rather than the '308 application;
- when the original petition as lodged (incorrectly) by Petitioner in the '306 application was dismissed on 21 March, 2005, Petitioner reasserted/renewed the petition on 28 March, 2005—again in the instant (and incorrect) '306 application.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵ And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

As discussed above, the Office does not appear to have declared the instant application abandoned, and therefore neither a petition to revive nor a request to withdraw the holding of abandonment is appropriate in the premises as to the instant application.

Should Petitioner wish to address an abandonment matter in another application, Petitioner must—as required by the rules of practice discussed above—file the appropriate papers in the other application. However, in the instant application there appears to be no matter in contest.

CONCLUSION

Accordingly, the petition:

- under 37 C.F.R. §1.137(a) is **dismissed as moot**; and
- as considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181 is **dismissed as moot**.

There should be no need for further correspondence with respect to this matter, however, should for some reason Petitioner find the need therefor, further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)⁸
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁸ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By FAX: IFW Formal Filings
(703) 872-9306
(Effective 28 September, 2004: (571-273-0025)
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Lobby/Room 1B03
Crystal Plaza Two
220 20th Street S.
Arlington, VA 22202

The instant application is released to OIPE for further processing as necessary before being forwarded for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'John J. Gillon, Jr.', with a stylized flourish extending from the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions